

100200145-1

10/053,463

IN THE DRAWINGS:

The recent Office Action objected to the drawings due to minor inconsistencies in the use of reference numbers. Accordingly, a replacement sheet bearing Fig. 3 has been filed herewith.

In the replacement for Fig. 3, reference number (110) referring to "Other concentrated apps" has been changed to (111); and reference number (109) referring to "Virtual machine data store" has been changed to (112). No other changes were made; no new matter has been added. Therefore, entry of the replacement sheet bearing the revised Fig. 3 and a withdrawal of the objection to the drawings are respectfully requested.

100200145-1

10/053,463

REMARKS

This is a full and timely response to the non-final Official Action mailed **February 8, 2008** (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, the specification and various claims have been amended. No claims are added or cancelled. Thus, claims 1-23 are currently pending for further action.

Substitute Specification:

Applicant has filed a substitute specification with this paper. In the substitute specification, various stylistic and typographical changes have been made to improve the specification. No new matter has been added. Therefore, entry of the substitute specification is respectfully requested.

Objection to the Drawings:

The recent Office Action objected to the drawings due to minor inconsistency in the use of reference numbers. (Action, p. 2). Accordingly, a replacement sheet bearing Fig. 3 has been filed herewith.

In the replacement for Fig. 3, reference number (110) referring to "Other concentrated apps" has been changed to (111), and reference number (109) referring to "Virtual machine data store" has been changed to (112). No other changes were made; no new matter has been added. Therefore, entry of the replacement sheet bearing the revised Fig. 3 and a withdrawal of the objection to the drawings are respectfully requested.

100200145-1

10/053,463

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claims 20-23 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims were indefinite as filed, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Prior Art:

Claims 1-5, 8-13, 15-18 and 20 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,163,780 to Ross ("Ross") and U.S. Patent No. 6,131,192 to Henry ("Henry"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in the MPEP § 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a

100200145-1

10/053,463

claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

To support an obvious rejection it is important to clearly understand all of the elements of the claims at issue, for each element must be found in the prior art references cited as a matter of actual inquiry before proceeding. Accordingly, a review of the independent claims the scope and content of the cited references is in order.

100200145-1

10/053,463

Claim 1:

Claim 1 recites:

A method of installing an application on a target electronic device, said method comprising:
receiving said application in said target device in unconcentrated form;
concentrating said application in said target device; and
installing said concentrated application in concentrated form in non-volatile memory of said target device.

Support for the amendment to Claim 1 can be found in Applicant's originally filed specification at, for example, paragraphs 0046, 0047 and 0050. In contrast, the cited prior art, taken in any combination, does not appear to teach or suggest all the features of Claim 1.

As cited in the Action, "Ross discloses a system and method for receiving bytecode and condensing bytecode, comprising: - *receiving said application in said target device in unconcentrated form*; - *concentrating said application in said target device*." (Action, p. 4). However, it does not appear that the cited portion of Ross actually teaches a method that includes concentrating an application in a "target device" where that application is to be installed.

The Action cites Ross at col. 5, lines 20-22. (Action, p. 4). Given some additional context that the Office Action unfortunately ignores, that portion of Ross states the following.

The data processing system 40 may be a free standing system, providing bytecode concentrated in accordance with the present invention to a server 10 for transmission over the ["electronic communications network"] ECN 20. Alternatively, a server 10 may comprise the data processing system 40. Alternatively, the data processing system 40 may be in communication with user systems 30 via the ECN. In another embodiment, the data processing system 40 may receive bytecode, concentrate it on-the-fly in accordance with the present invention and then transmit it, such as to a server 10, or to another system via the ECN.

100200145-1

10/053,463

The bytecode to be condensed may also be transmitted on-the-fly to the data processing system 40, which in turn concentrates the bytecode on-the-fly and re-transmits the condensed bytecode.

(Ross, col. 5, lines 1-22) (emphasis added).

Thus, as cited by the recent Office Action, Ross teaches a “free standing system” that can be accessed via a network. Bytecode is transmitted to the free standing system (40) which then “concentrates the bytecode on-the-fly and re-transmits the condensed bytecode” to a client device, “such as to a server 10, or to another system via the ECN.” (*Id.*) (emphasis added). This is not a teaching or suggestion, as erroneously alleged in the recent Office Action, of “concentrating said application in said target device,” as recited in Claim 1. Thus, the recent Office Action has failed to properly ascertain the differences between the cited prior art and the subject matter of Claim 1.

Additionally, the recent Office Action holds that Ross does not teach installing said concentrated application in non-volatile memory of said target device. (Action, p. 4). Consequently, the Action cites to Henry as teaching this subject matter in combination with Ross. (Action, p. 5). Applicant respectfully disagrees and has amended the relevant portion of Claim 1 to make it more explicit that the concentrated application is installed “in concentrated form.” (Claim 1).

In contrast, Henry merely teaches decompressing a source file containing executable files and then installing the decompressed files. Specifically, Henry teaches the following.

An executable file contains materials necessary for the installation of a software product, and the executable file is executed to provide a compressed file and a shell program module. The shell program module locates a suitable temporary storage space, extracts the compressed file from the initial executable file, and places the compressed file in the temporary storage space. The initial executable file causes a second executable file to be extracted from the compressed file and executed, so that a setup program module is run. In response to execution of the setup program module,

100200145-1

10/053,463

files are sequentially decompressed from the compressed file. A newly decompressed file may initially be placed in the temporary storage space, and the decompressing is paused until that newly decompressed file is copied to a target storage space. The newly decompressed file may be renamed or decompressed while being copied to the target storage space. Thereafter, that newly decompressed file is deleted from the temporary directory. This process is repeated until multiple files originating from the compressed file are in their respective directory of a directory tree created in the target directory. Alternatively, newly decompressed files may be placed directly in the target storage space. Thereafter, the setup program module prepares the data and information on the computer so that the software product will work with the computer and its attached devices. Once the setup program module is no longer running, files remaining in the temporary storage space as a result of execution of the shell program module are deleted from the temporary storage space, and execution of the shell program module is terminated.

(Henry, abstract).

Thus, Henry does not, as suggested by the Office Action, teach or suggest installing a compressed application. Henry decompresses the source files before installation. Moreover, Henry clearly does not teach or suggest installing a concentrated application "in concentrated form" as recited in Claim 1. Henry explicitly teaches decompressing that data before installation. Here again, the Office Action has failed to appropriately ascertain the differences between the cited prior art and the subject matter of Claim 1.

In light of the above summary of the cited prior art and Claim 1, it is respectfully submitted that the recent Office Action has failed to resolve the *Graham* factual inquiries by failing to properly ascertain the actual differences between the cited prior art references and Claim 1 for at least the following reasons:

- The citation to Ross does not actually disclose "concentrating said application *in said target device*," as recited in Claim 1.
- Henry does not actually disclose "installing said concentrated application *in concentrated form* in non-volatile memory of said target device," as recited in Claim 1.

100200145-1

10/053,463

As the *Graham* factual inquiries are not properly resolved, application of any of the rationales (A)-(G) as set forth in the guidelines is futile because Ross and Henry, alone or in combination, fail to provide all of the claim elements as set forth in Claim 1.

Moreover, the differences between the cited prior art and Claim 1 are substantial in that Claim 1 recites subject matter with attendant advantages that were not recognized or available from the cited prior art to Ross and Henry. For at least these reasons, the cited prior art will not support a rejection of claim 1 and its dependent under 35 U.S.C. § 103 and *Graham*, and the rejection should be reconsidered and withdrawn.

Claim 9:

Claim 9 recites:

An installer program stored on a medium for storing computer-readable instructions, said installer program, when executed, causing a host device to:
concentrate an unconcentrated application; and
install said concentrated application in concentrated form in non-volatile memory of said host device.

Support for the amendment to Claim 9 can be found in Applicant's originally filed specification at, for example, paragraphs 0046, 0047 and 0050.

In contrast to Claim 9, the cited prior art, taken in any combination, does not appear to teach or suggest all the features of Claim 9 for at least the same reasons given above with respect to the patentability of Claim 1. Specifically, the cited prior art does not disclose the claimed installer program causing a host device to "concentrate an unconcentrated application; and install said concentrated application in concentrated form in non-volatile memory of said host device." (Claim 9). Therefore, the cited prior art will not support a

100200145-1

10/053,463

rejection of claim 9 and its dependent under 35 U.S.C. § 103 and *Graham*, and the rejection should be reconsidered and withdrawn.

Claim 15:

Claim 15 recites:

A system for installing an application on a target electronic device, said system comprising:
means for concentrating said application in said target device; and
means for installing said concentrated application in non-volatile memory of said target device.

In contrast to Claim 15, the cited prior art, taken in any combination, does not appear to teach or suggest all the features of Claim 15 for at least the same reasons given above with respect to the patentability of Claim 1. Specifically, the cited prior art does not disclose the claimed system with “means for concentrating said application in said target device; and means for installing said concentrated application in non-volatile memory of said target device.” (Claim 15) (emphasis added). Therefore, the cited prior art will not support a rejection of claim 15 and its dependent under 35 U.S.C. § 103 and *Graham*, and the rejection should be reconsidered and withdrawn.

Claim 20:

Claim 20 recites:

An electronic target device that hosts applications, said target device comprising:
non-volatile memory; and
an installer program configured to concentrate an application in said target device and install said application in concentrated form in said non-volatile memory of said device.

100200145-1

10/053,463

In contrast to Claim 20, the cited prior art, taken in any combination, does not appear to teach or suggest all the features of Claim 20 for at least the same reasons given above with respect to the patentability of Claim 1. Specifically, the cited prior art does not disclose the claimed target device with "an installer program configured to concentrate an application in said target device and install said application in concentrated form in said non-volatile memory of said device." (Claim 20) (emphasis added). Therefore, the cited prior art will not support a rejection of claim 20 and its dependent under 35 U.S.C. § 103 and *Graham*, and the rejection should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. For example, Claim 2 recites "wherein said concentrating and installing of said application are contemporaneously performed." In contrast, as noted above, Ross, as cited in the recent Action, teaches a stand alone device to which code is sent for concentration before being ultimately delivered to a client device. Consequently, the cited prior art would not seem to disclose the subject matter of claim 2.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

100200145-1

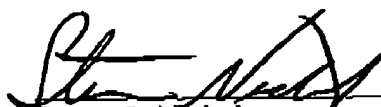
10/053,463

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: May 7, 2008


Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **May 7, 2008**. Number of Pages: **32**


Carla L. Jones